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8 UNITED STATES DISTRICT COURT
9 EASTERN DISTRICT OF CALIFORNIA

11 Nutrishare, Inc., a California corporation,

12 Plaintiff,

13 v.

14 BioRx, LLC, an Ohio Limited Liability
15 Company,

16 Defendant.

Case No. 2:08-CV-01252-WBS-EFB

**REPLY IN SUPPORT OF MOTION FOR
PRELIMINARY INJUNCTION**

ORAL ARGUMENT REQUESTED

Date: August 18, 2008
Time: 2:00 p.m.
Dept: Courtroom 5
Judge: Hon. William B. Shubb

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1 **I. INTRODUCTION**

2 After establishing its brand identity and reputation over nearly two decades of hard work
3 and dedication to its patients, Nutrishare is now in the untenable position of not only losing
4 market share to a copycat business, but of now having the reputation of its brand name at risk of
5 being tarnished or destroyed altogether while in the hands of a third party. That is the necessary
6 result when a competitor such as defendant Nutrithrive here begins using a mark that is likely to
7 cause consumer confusion as to the source, sponsorship, or affiliation. Aside from the
8 presumption of irreparable harm the flows from the likelihood of confusion determination, the
9 threatened loss of market share from a direct competitor also establishes irreparable harm.

10 BioRx's opposition is replete with hyperbole and overstatements. None of its arguments
11 have any merit. Laches is not a defense to this action or this motion. The Nutrithrive mark is
12 strong, and all of the *Sleekcraft* factors weigh in favor of a finding of infringement. Recognizing
13 the weakness of its arguments, BioRx engages in an effort at misdirection, and would have the
14 Court believe that Nutrishare's motion seeks to "shut down NutriThrive" and prevent BioRx from
15 "providing enteral care and other infusion products and services," (Opposition to Motion for
16 Preliminary Injunction, filed 8/4/08 (hereinafter "Opp.") at 19:16.). This could not be farther
17 from the truth. Nutrishare merely seeks an injunction requiring BioRx to cease using a name
18 which is likely to cause consumer confusion. BioRx can continue to engage in any business it
19 chooses, as long as it does so in a manner that is not likely to cause consumer confusion.

20 Where, as in this case, the public welfare is also implicated in view of the nature of the
21 competing pharmaceutical products at issue, the need to avoid consumer confusion is that much
22 more compelling. This case is about "dangerous drugs or dangerous devices" as defined by the
23 California Business & Professions Code, which are prescribed by doctors and dispensed by
24 licensed pharmacies. Confusion about source, affiliation, sponsorship, or relationship of such
25 products could lead to tragic consequences. Accordingly, preliminary injunctive relief to protect
26 both Nutrishare and the consuming public during the pendency of this action is absolutely
27 necessary and appropriate.

II. LEGAL ARGUMENT

A. NUTRISHARE IS LIKELY TO SUCCEED ON THE MERITS OF ITS CLAIMS.

1. Nutrishare Has Established a “Likelihood of Confusion.”

In its moving brief, Nutrishare demonstrated why it is likely to prevail on each of the eight “likelihood of confusion” factors under *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979). BioRx’s response incorrectly analyzes several of the factors, and completely fails to address two critical *Sleekcraft* factors: (1) the relatedness or proximity of the goods and services; and (2) the marketing channels used. (*See generally* Opp.) BioRx’s failure to discuss these key factors can only mean that BioRx admits that: (1) the NutriThrive goods and services are essentially identical to Nutrishare’s goods and services; and (2) both parties utilize identical marketing channels. BioRX’s failure to address these factors strongly suggest that Nutrishare is likely to succeed on the merits of its claims. *See Brookfield*, 174 F.3d at 1054 (relatedness of goods and services “will always be important”); *GoTo.com, Inc. v. The Walt Disney Co.*, 202 F.3d 1199, 1207 (9th Cir. 2000) *GoTo.com*, 202 F.3d at 1207 (use of same marketing channels, especially the Internet, “is particularly susceptible to a likelihood of confusion.”)

Even if the Court were to consider the remaining *Sleekcraft* factors, BioRx’s arguments on these factors are unavailing.

a. **Strength of the Mark.**

In its moving brief, Nutrishare demonstrated why the “Nutrishare” mark at a minimum is entitled to protection as a “suggestive” mark under *Nutri/System, Inc. v. Con-Stan Industries, Inc.*, 809 F.2d 601 (9th Cir. 1987), which holds that Plaintiff’s “Nutri/System” mark was entitled to protection as a “suggestive” mark. Furthermore, Nutrishare established that its seventeen-year campaign of building a name and reputation around its “Nutrishare” mark has only strengthened the mark.

BioRx’s response turns the *Nutri/System* case on its head and argues that, if the *Nutri/System* court found “Nutri”-prefix marks to be suggestive in “food and health products field” (*Nutri/System*, 809 F.2d at 605), then that necessarily means that “Nutri”-prefix marks are

generic or descriptive in the nutrition industry and not entitled to protection.¹ BioRx's argument is belied by its own actions, and characterization of the products and services at issue in this case. This case is not about energy bars, Vitamin Water or any other run-of-the-mill "nutritional" product, as BioRx would have the Court believe. This case is about "dangerous drugs or dangerous devices" as defined by the California Business & Professions Code. *See* Bus. & Prof. Code § 4051. This case is about medicine and pharmaceuticals. If parenteral and enteral nutrition were not medicine, but rather, simply a nutritional product such as baby formula, then there would be no requirement that doctors prescribe, or that licensed pharmacies dispense it. (*see* Opp. at 3:21-22). There would have been no reason for BioRx to obtain a pharmacy license with the California Board of Pharmacy. There would have been no basis for BioRx to have applied for registration of the "NutriThrive" name in the category of "medical services" and "pharmaceutical preparations." (*See* Opp. at 4:27-5:7.) BioRX took all of these actions because it clearly understands and admits that the products and services that it and Nutrishare provide are pharmaceuticals.

Furthermore, although *Nutri/Systems* represents an example of a case involving "Nutri"-prefix marks, that is the extent of its relevance to this case: that is, it is only an example and its "likelihood of confusion" analysis is by no means controlling. Likelihood of confusion is determined on a case-by-case basis only after examining all eight *Sleekcraft* factors. Accordingly, just because the Ninth Circuit previously held a "Nutri"-prefix mark not to be infringed in one unique situation, does not mean that all courts of this circuit should across the board find that "Nutri"-prefix marks are not entitled to any trademark protection.

More importantly, although the marks at issue in *Nutri/Systems*, like the marks at issue in this case, contain "Nutri" prefixes, the similarity in the cases ends there. Specifically:

- *Nutri/Systems* was about health food products. *Id.* at 605. By contrast, this case is about medical products and pharmaceuticals.
- The competing marks in *Nutri/Systems* – "Nutri/Systems" and "Nutri-Trim" – were completely dissimilar, containing different punctuations between the

¹ Interestingly, by applying for a federal trademark for the mark Nutrithrive, BioRX is necessarily representing to the USPTO that its mark is distinctive and entitled to full protection under the Lanham Act.

“Nutri” prefix and the suffix, and containing completely different suffixes that do not share the same number of syllables or other linguistic characteristics. *Id.* at 606. By contrast, the marks in this case are very similar, both containing no punctuations between the “Nutri” prefix and the suffixes, and both containing single-syllable suffixes that begin with rhyming digraphs and end in a silent “e.”

- The marketing channels and customer base for the products and services in *Nutri/Systems* were completely different, with both parties serving different socioeconomic groups. *Id.* By contrast, the marketing channels in this case are identical.
- The defendant in *Nutri/Systems* had been using the “Nutri”-prefix to market its products long before the plaintiff even existed. *Id.* at 606. By contrast, BioRx began using the “Nutri” prefix only one year ago and sixteen years after Nutrishare started using the “Nutri” prefix to identify its products and services.
- The sales volumes in *Nutri/Systems* were so high that the few instances of actual confusion were considered “de minimis.” *Id.* By contrast, here, the sales volumes of the parties’ products are so low – in the tens (Opp. at 5:26-27) – that even a single instance of actual confusion is highly probative.

In addition to improperly relying on the *Nutri/Systems* case, BioRx also improperly dissects the “Nutrishare” mark to argue that the “Nutri” root stem is generic of nutritional products, and therefore entitled to little weight in considering a likelihood of confusion. However, the strength of the “Nutrishare” mark should not be determined by dissecting the mark into separate components, but rather, by analyzing the mark “in its entirety and in the context of [the relevant] services, not piecemeal and in the abstract.” *Rodeo Collection, Ltd v. West Seventh*, 812 F.2d 1215, 1218 (9th Cir. 1987) (West Seventh mistakenly focused on part of Rodeo’s mark, ‘collection,’ and then argued that the overall mark was weak because the phone book revealed eleven other business uses of the term ‘collection.’); *Official Airlines Guides, Inc. v Goss*, 6 F.3d 1385 (9th Cir. 1993) (“under the anti-dissection rule, the validity and distinctiveness of a composite trademark is determined by viewing the trademark as a whole, as it appears in the marketplace.”) Thus, one must consider the specific associations that the *composite* mark triggers in the minds of consumers when it is used on the identified goods and/or services. In this case, customers are unlikely to dissect the marks and consider the “thrive” and “share” portions independently of the “Nutri” prefixes. And indeed, as explained in Nutrishare’s moving brief, it is the “Nutri” prefixes that will dominate the minds of the consumers as they observe the marks in

1 the marketplace.²

2 As further “support” for its erroneous argument that the “Nutrishare” mark is allegedly
3 weak, BioRx cites to examples of marks where the USPTO purportedly “required a disclaimer of
4 the phrase ‘nutri’ or ‘nutra’.” (Opp. at 8:25-9:8.) BioRx opines “[t]his list of disclaimed
5 Nutri/Nutra marks is further evidence that ‘nutri’ is a weak source identifier for nutrition
6 products.”

7 Given BioRX's reliance on US Patent and Trademark Office practice, one must question
8 why BioRX chose not to disclose the *Guaber, S.P.A. v. Nutri-Metics Int'l, Inc.*, 1991 U.S. App.
9 LEXIS 10842, 1-5 (Fed. Cir. 1991) decision. In that case, the Court of Appeals for the Federal
10 Circuit affirmed the TTAB's determination that the marks “Nutromed” and “Nutri-metrics” were
11 likely to cause consumer confusion.

12 Moreover, BioRx's purported list of disclaimers (Opp. at 8:27-28) is evidence of nothing.
13 As a matter of law, “the technicality of a disclaimer . . . has no legal effect on the issue of
14 likelihood of confusion” because (1) “The public is unaware of what words have been disclaimed
15 during prosecution of the trademark application at the PTO;” (2) “The power of the PTO to
16 accept or require disclaimers is discretionary under the statute;” and (3) “its practice over the
17 years has been far from consistent.” *In re National Data Corp*, 753 F.2d 1056 (Fed. Cir. 1985).
18 A review of the USPTO file history of other marks containing the “Nutri” prefix only confirms
19 that the USPTO is indeed inconsistent in requiring a disclaimer of “Nutri,” and follows no
20 particular formula in this regard. (Declaration of Ellen Tenud in support of Reply in support of
21 Motion for Preliminary Injunction, filed herewith (hereinafter “Tenud Decl.”), ¶ 6, Ex. C.) Thus,
22 “it is inappropriate to give the presence or absence of a disclaimer any legal significance.” *Id.*

23 ² Contrary to BioRx's assertion that Nutrishare has improperly dissected the marks by noting that the “nutri” prefix is
24 the dominant feature of the mark, (Opp. at 11:3-4), as discussed in Nutrishare's moving brief, focusing on the
25 dominant “Nutri” feature of the mark “does not amount to a dissection of the mark” (*Guaber*, 1991 U.S. App. LEXIS
26 10842 at * 3; McCarthy, § 23:42) and courts of this circuit have routinely found a likelihood of confusion based on
27 the parties' use of identical dominant features. *See, e.g., Paul Sachs Originals Co. v. Sachs*, 325 F.2d 212 (9th Cir.
28 1963); *Century 21 Real Estate Corp. v. Magee*, 19 U.S.P.Q.2d 1530 (C.D. Cal. 1991) (“CENTURY 21” and
“CENTURY 31” for real estate services); *Earth Technology Corp. v. Environmental Research & Technology, Inc.*,
222 U.S.P.Q. 585 (C.D. Cal. 1983) (“ERT” and “ERTEC” for environmental consulting services; preliminary
injunction granted); *Alfacell Corp. v. Anticancer Inc.*, 71 U.S.P.Q.2d 1301 (C.D. Cal. 2004) (“ONCANASE” and
“ONCASE” for anti-cancer drugs); *Russell v. Caesar*, 62 U.S.P.Q.2d 1125 (N.D. Cal. 2001) (“RABBIT RIDGE” and
“RABBIT HILL” for wine).

1 Furthermore, without reviewing the history of each of the marks in BioRx's "list," it is impossible
2 to know if the disclaimed matter was disclaimed voluntarily, or *required* by the USPTO. What
3 Nutrishare does know is that the first three references relied upon by BioRx are all for the
4 identical mark, owned by the same entity. (*See* Declaration of Steven Coffaro in support of Opp.,
5 filed 8/4/08, Ex. C.) Therefore, BioRx's alleged evidence of disclaimers is unavailing.

6 BioRx also attempts to contrive a "crowded" field of "Nutri" prefix marks in the
7 parenteral nutrition industry by listing three trademark registrations that BioRx alleges show
8 "entities offering parenteral nutrition-related products and services that currently use a 'nutri'
9 prefix." (Opp. at 9:19-26.) This argument too holds no water. First, two of these registrations
10 have been cancelled. (*See id.*) Second, the existence of one live trademark registration does not
11 constitute proof that the owner of that registration currently offers parenteral nutrition-related
12 products and services. Succinctly stated, the fact that these registrations exist on paper or on the
13 USPTO's Register has no bearing in the real world.

14 Next, BioRx refers to two website addresses – www.nutrepletion.com and
15 www.nutricia.com – to support the argument that "the marketplace includes other providers of
16 nutritional therapies with similar names." (Opp. at 10-11.) Initially, there is no evidence before
17 the court as to what markets these supposed businesses actually serve, what geographic regions
18 they serve, or whether they are able to actually do business.

19 Moreover, a review of these websites reveals that "Nutrepletion Resources" and
20 "Nutricia" are merely trade names of businesses, and not product identifiers. (Tenud Decl., ¶ 7.)
21 In fact, Nutricia uses other trademarks for its supposed products such as Nutilus, Nutrilon Royal,
22 Forticare, and Flocare. (*Id.*) In addition, neither Nutricia nor Nutrepletion offers total parenteral
23 services. (*Id.*) Therefore, BioRx's assertions that the existence of these two websites and the use
24 of these trade names "conclusively shows" that Nutrishare's mark "is neither unique or
25 uncommon" is simply false.

26 In summary, the "Nutrishare" mark, when considered as a whole as it must be considered,
27 is a strong mark and this factor weighs in favor of finding a likelihood of confusion.

28 ///

b. Similarity of the Marks.

The “Nutrishare” and “NutriThrive” marks are confusingly similar on several grounds. Both marks start with the identical term “Nutri” and end with single syllable suffixes that are nearly the same in length (5 versus 6 letters), and which begin with the rhyming digraphs³ “sh” and “th,” followed by “are” and “rive,” which contain silent “e’s.” Moreover, the two marks share the same cadence, word structure, and differ in length only by one letter, and neither has any punctuation. *See, e.g., Earthquake Sound Corporation v. Bumper Industries, Inc.*, 188 F.3d 513 (9th Cir. 1999) (finding likelihood of confusion where “Both Earthquake and Carquake are one word, two syllable marks of the same length, ending in ‘quake.’”); *Personeta, Inc. v. Persona Software, Inc.*, 418 F.Supp.2d 1013, 78 U.S.P.Q.2d 1142 (N.D. Ill., 2005) (finding likelihood of confusion between “Personeta, Inc.” and “Persona Software, Inc.” on the grounds that “both marks have the identical six letters, and both end in an ‘a.’ [and] although Personeta contains an extra syllable, the term ‘person’ is identical in the two names”

In its argument that the “Nutrishare” and “NutriThrive” marks are not similar, BioRx engages in a side-by-side comparison and dissection of the marks at issue, neither of which are the proper test for determining likelihood of confusion. *See MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* (hereinafter “MCCARTHY”), § 23:41 (Fourth Ed. 2008).

Side-by-side comparisons are inappropriate based on the common sense observation that the impression of a mark is created by the purchaser’s cursory reaction to a mark in the marketplace, not a meticulous comparison of it to others to access possible legal differences or similarities. Indeed, purchasers do not have the luxury of making a side-by-side comparison between the marks. They are not infallible in their recollection of trademarks and often retain only a general overall commercial impression of marks that they may have previously seen in the marketplace. This is particularly true in the present case because the marks are visually seen at separate times in the point-and-click world of the Internet, where slight differences are not likely to be noted or remembered by consumers and where their respective digraphs – “sh and “th” –

³ A digraph is a linguistic term for a pair of letters representing a single speech sound, as “ea” in meat or “th” in path. *THE NEW SHORTER OXFORD ENGLISH DICTIONARY* (ed. Leslie Brown), Clarendon Press, Oxford (1993), at 671.

1 can be easily mistaken for each other.

2 Nor is dissection appropriate. It is well-settled that composite marks should be examined
3 in their entirety, not piece by piece. *Rodeo, supra*. This is because the commercial impression of
4 a mark on an ordinary consumer is created by the mark as a whole, and not only by its component
5 parts. In this respect, the Court must look beyond the mere suggestiveness or descriptiveness of
6 any one portion or component of the marks and evaluate the likelihood of confusion on the basis
7 of the commercial impression that the marks as a whole convey to prospective purchasers.

8 It is furthermore unlikely that purchasers will be able to mentally and visually dissect the
9 marks into two separate components, disregard the identical term “Nutri,” and compare only
10 “share” to the “Thrive.” Rather, consumer, being familiar with Nutrishare’s mark, and
11 encountering the “NutriThrive” mark on identical goods, likely will confuse the marks, and
12 misremember one as the other, or mistakenly conclude that there is an association, sponsorship, or
13 affiliation between Nutrithrive and Nutrishare. *Au-Tomotive Gold, Inc. v. Volkswagen of Am.,*
14 *Inc.*, 457 F.3d 1062, 1075-76 (9th Cir. 2006). (“There is a likelihood of confusion when
15 consumers who see a mark ‘would probably assume that the product or service it represents is
16 associated with the source of a different product or service identified by a similar mark.’”);
17 *Lambert Pharmacal Co. v. Kalish Pharmacy*, 219 F. 323 (C.C.N.Y. 1911) (“The trade-name
18 [Listerseptine] was chosen by the defendant...about 17 years after complainant’s origination of
19 the trade-mark ‘Listerine.’ The similarities of the names in appearance and sound, when
20 considered with the similarity of the articles to which the trade-names are applied, is clearly
21 apparent, and the probabilities of the defendant’s designation misleading the unwary customer in
22 my opinion is so clear that it amounts to infringement of the complainant’s trade-mark.”)

23 Thus, the “Nutrishare” and “NutriThrive” marks are highly similar, and this factor favors
24 Nutrishare.

25 **c. Evidence of Actual Confusion.**

26 The Ninth Circuit has recognized that evidence of actual confusion is not required to find
27 a likelihood of confusion, and it is certainly not a prerequisite to issuing a preliminary injunction.
28 *American Int’l Group v. American Int’l Bank*, 926 F.2d 829, 832 (9th Cir. 1991); *Eclipse*

1 *Associates Ltd. v. Data General Corp.*, 894 F.2d 1114 (9th Cir. 1990). However, “[e]vidence of
2 actual confusion constitutes persuasive proof that future confusion is likely.” *Thane Int’l v. Trek*
3 *Bicycle Corp.*, 305 F.3d 894, 902 (9th Cir. 2002).

4 In its moving and supplemental declarations, Nutrishare demonstrated that, within six
5 months of its launch, BioRx already has caused doctors, nurses, pharmacists, and other medical
6 professionals to become confused regarding the relationship, sponsorship, or affiliation between
7 NutriThrive and Nutrishare. These instances are chronicled in great detailed in the original and
8 supplemental declarations of Rod Okamoto⁴ and the declarations of Reid Nishikawa, Anita
9 Wallin, and Kerry Stone filed in support of this motion. (Okamoto Decl. ISO Moving Brief, filed
10 6/24/08, ¶ 16; Nishikawa Decl. filed 6/24/08, ¶ 4; Wallin Decl filed 6/24/08, Stone Decl. filed
11 7/8/08, Suppl. Okamoto Decl. filed 7/8/08).

12 In its opposition, BioRx relies on cases from other jurisdictions (while conveniently
13 ignoring controlling 9th Circuit authority) in an erroneous effort to discredit this evidence of
14 actual confusion by stating that these individuals were not actually confused, but merely raised
15 “questions as to whether Plaintiff and Defendant are connected” and asked to “clarify the
16 relationship, if any, between NutriThrive and Nutrishare.”⁵ (Opp. at 12:10-17.)

17 This argument is nonsensical. Pure logical deduction and plain common sense indicates
18 that if someone enquires regarding whether two companies are connected or related, and seeks
19 clarification regarding the same, that person by definition is “confused” regarding the affiliation
20 or relationship between the companies. Controlling law confirms common sense. BioRx’s
21 citations to non-controlling law from the Eighth and Second Circuits are inappropriate and
22 misleading. (See Opp. at 13:5-16.) Courts of this circuit have accepted such inquiries regarding
23

24 ⁴ BioRx has attempted to attack the veracity of Mr. Okamoto's original and supplemental declarations, in which Mr.
25 Okamoto discusses instances related to confusion between the "Nutrishare" and "NutriThrive" marks. (See Decl. of
Timothy Fensky filed 8/4/08; Decl. of Eric Hill filed 8/8/08). As explained in Mr. Okamoto's reply declaration filed
herewith, BioRx's attacks are unavailing.

26 ⁵ BioRx also argues that the Declaration of Sheila Messina, which Nutrishare filed on 7/28/08 in support of its
27 Opposition to BioRx’s Motion to Dismiss or Transfer Venue, is not evidence actual confusion. (Opp. at 12:22-25.6.)
28 But Nutrishare did not submit Ms. Messina’s declaration to show that Ms. Messina was confused. Rather, Nutrishare
submitted this declaration in connection with BioRx’s pending Motion to Dismiss or Transfer Venue to show that
NutriThrive was actively marketing to California residents at a conference in California.

1 affiliation as evidence of actual confusion. *Steinway & Sons v. Demars & Friends*, 210 U.S.P.Q.
 2 954, 1981 U.S. Dist. LEXIS 15169, at *36 (C.D. Cal. 1981) (considering evidence that plaintiff's
 3 retailers and wholesalers were making inquiries about a connection between the parties); *see also*
 4 *Kroger Co. v. Suprex, Inc.*, 193 U.S.P.Q. 245, 247 (E.D. Pa. 1976) ("customers evidenced such
 5 confusion by inquiring as to whether defendant's store was affiliated with [plaintiff's] national
 6 chain"). The *Steinway* court specifically held that

7 Since reliable evidence of actual confusion is difficult to obtain in trademark
 8 infringement cases, any such evidence is substantial evidence that confusion is
 9 likely. . . . Very little proof of actual confusion [is] necessary to prove likelihood
 of confusion.

10 *Steinway & Sons*, 1981 U.S. Dist. LEXIS 15169, at *36. Thus,

11 Moreover, contrary to BioRx's claims that "there has been *no confusion* between the two
 12 marks [because] third parties have actually recognized a difference between them" (Opp. at
 13 12:13-15), actual confusion need not occur only as to the source of the parties' products and/or
 14 services. Rather, under the plain words of the Lanham Act, confusion that gives rise to a
 15 trademark infringement or unfair competition claim can also be about the "affiliation, connection,
 16 or association" between the parties. *See* Lanham Act section 43(a), 15 U.S.C. section 1125(a);
 17 *Brookfield Communs. v. W. Coast Entm't Corp.*, 174 F.3d 1036 (9th Cir. 1999) (holding that
 18 Lanham Act protects against many forms of confusion); *see also Champions Golf Club v.*
 19 *Champions Golf Club*, 78 F.3d 1111 (6th Cir. 1996) (where there were two golf courses named
 20 "Champions," the issue was not whether golfers were confused about which course they were
 21 playing on, but rather, whether the courses were affiliated).

22 23 **d. Degree of Purchaser Care.**

24 In its opposition, BioRx argues that the "customers" for TPN and enteral products are
 25 doctors and pharmacists, and that these customers are not likely to be confused about the source,
 26 affiliation or sponsorship of Nutrishare and NutriThrive's products and services because they are
 27 "as sophisticated a group as one could imagine." (Opp. at 14:4-15:5.)

28 This argument is specious given that the "pharmacist" is not BioRx's "customer" – rather,

1 BioRx is the pharmacist. Nutrishare's customer is the TPN patient, and not the doctor or
 2 pharmacist. (Reply Okamoto Decl., ¶7.) Moreover, BioRx's argument is akin to claiming that
 3 companies like Walgreens and Rite-Aid are marketing directly to doctors, and not to end users of
 4 pharmaceuticals. BioRx's argument is particularly ludicrous in light of the fact that BioRx admits
 5 that it is working directly with a patient family in Redding, not with their doctor. Moreover,
 6 BioRx's web-site for its NutriThrive products obviously is directed to the end user, and not
 7 medical professionals. It is the TPN consumer, not the doctor, who would sign up on-line to be a
 8 "NutriThrive customer." It is the TPN consumer, not the doctor, who would post messages on the
 9 on-line message board asking NutriThrive's clinician team for advice. And if BioRx was more
 10 concerned about marketing to doctors, it would not have attended the Oley Conference, which is a
 11 consumer-oriented conference, and it would not have aggressively solicited TPN consumers at
 12 that conference.

13 Even assuming, *arguendo*, the thrust of BioRx's marketing is directed to doctors, and not
 14 enteral and parenteral nutrition customers, it is very telling that even doctors – who BioRx alleges
 15 to be the most sophisticated of customers for medical products – have actually experienced
 16 confusion. Medical professionals are the proverbial "canary in the coal mine." If medical
 17 professionals are confused, there can be no question that lay persons will be even more confused.

18 Moreover, even doctors and pharmacists are not infallible, and can experience confusion
 19 despite their sophistication. *See e.g., Alfacell Corp. v. Anticancer Inc.*, 71 U.S.P.Q.2d 1301
 20 (TTAB 2004) ("there is no reason to believe that medical expertise as to pharmaceuticals will
 21 ensure that there will be no likelihood of confusion as to source or affiliation"); *Geigy Chemical*
 22 *Corp. v. Atlas Chemical Indus., Inc.*, 58 C.C.P.A. 972, 974 (C.C.P.A. 1971) ("Given even a
 23 moderate interval of time, and even though these are prescription drugs, we do not feel that
 24 physicians who prescribe these two diuretics would be immune from confusion either as to the
 25 products or their source. The prefixes HYDRO- and HYGRO- sound very much alike and convey
 26 almost the same meaning. There is also an obvious similarity in the last four letters of the marks,
 27 -ONOL and -OTON"); *Syntex Laboratories, Inc. v. Norwich Pharmacal Co.*, 437 F.2d 566, 569
 28 (2d Cir. 1971) (pharmacists can be confused "if the prescriptions are written, because of

1 physicians' illegible style, or if they are telephoned, because of the phonetic similarities.”)

2 Finally, when there is a strong likelihood of confusion created by other factors, even the
3 existence of the most discerning customer base will not be sufficient to tip the scales in favor of
4 the infringer. MCCARTHY, § 23:103.

5 **e. Intent to Deceive Consumers.**

6 BioRx cites to no authority for its argument that, although it had actual and constructive
7 knowledge of Nutrishare's mark, there is no evidence of intent to deceive. (Opp. at 15.)
8 Controlling law does not require Nutrishare to show that BioRx adopted its mark with the
9 specific purpose of infringing Nutrishare's mark. *Daddy's Junky Music Stores v. Big Daddy's*
10 *Family Music*, 109 F.3d 275, 287 (9th Cir. 1997). Rather, it is sufficient that, despite having an
11 “infinity” of names to choose from, BioRx adopted its confusingly similar “NutriThrive” mark
12 with actual or constructive knowledge of Nutrishare's mark. *Id.* (citing *Official Airlines Guides*,
13 6 F.3d at 1394); *see also Stork Restaurant v. Sahati*, 166 F.2d 348 (9th Cir. 1948.)

14 It is also disingenuous for BioRx to deny that it intentionally hired spokespersons who are
15 former Nutrishare customers and/or family members, as it could not be purely coincidental that
16 these particular individuals – rather than any of the other 30-odd NutriThrive customers – became
17 BioRx's spokespersons. Accordingly, BioRx should be presumed to have acted with the intent to
18 deceive the public. *Brookfield*, 174 F.3d at 1059.

19 **f. Proximity of the Products and Services Offered by the Parties.**

20 Although BioRx has failed to specifically address this factor in its opposition brief, BioRx
21 has in various court filings and elsewhere in its opposition brief attempted to draw false
22 distinctions between “enteral” and “parenteral” nutrition in order to prove that the parties'
23 products and services are non-competitive. (Opp. at 5:27-28, BioRx's Motion to Dismiss or
24 Transfer Venue, filed 7/23/08, at 2:13-14.) In the event that BioRx intends to make such an
25 argument at the hearing on this motion, Nutrishare would like to dispel this argument once and
26 for all.

27 As an initial matter, BioRx's argument fails because both parties provide both enteral and
28 parenteral nutrition products and services to their customers. (Okamoto Decl. in support of

1 Nutrishare's Opp. to BioRx's Motion to Dismiss, filed 7/28/08, ¶ 14; Okamoto Decl. in support
 2 of Reply, filed herewith (hereinafter "Okamoto Reply Decl." ¶¶ 6-7.) And the customer base for
 3 these two products is essentially the same. Depending on their physical condition, some patients
 4 are on both enteral and parenteral therapy, some are exclusively on enteral therapy, some are
 5 exclusively on parenteral therapy, some are on enteral therapy and occasionally "revert" to
 6 parenteral therapy, and some are on parenteral therapy and may "graduate" to enteral therapy.
 7 (Okamoto Reply Decl., ¶ 6.) The products and services offered by the parties are therefore
 8 identical and competitive.

9 Moreover, BioRx's sales of even completely unrelated and noncompetitive products under
 10 the "NutriThrive" name can give rise to trademark infringement and unfair competition, as long
 11 as there is a likelihood of confusion about the source, affiliation, sponsorship, or relationship of
 12 the products and services offered by the two parties.

13 Competition between the parties is but one of eight factors the Court evaluates to
 14 determine whether the relevant consuming public is likely to be confused. *AMF Inc. v. Sleekcraft*
 15 *Boats*, 599 F.2d 341, 348 (9th Cir. 1979). In fact, the *Sleekcraft* test was developed for the very
 16 purpose of determining if there is infringement when the products "are not in direct competition"
 17 *Id.* at 348 (emphasis added). McCarthy's treatise on trademark law also echoes the sentiment that
 18 "The vast majority of modern decisions have adopted the rule that competition is not necessary
 19 between the parties for there to be a likelihood of confusion." MCCARTHY, §24:13. The
 20 Trademark Manual of Examining Procedure, published by the United States Patent and
 21 Trademark Office, likewise provides:

22 The goods or services do not have to be identical or even competitive in order to
 23 determine that there is a likelihood of confusion. . . . The issue is not whether the
 24 goods will be confused with each other, but rather whether the public will be
 confused about their source.

25 TMEP § 1201(a)(i).

26 Following this rationale, numerous courts of this and other circuits have held there to be
 27 infringement notwithstanding that the parties' products and/or services were not competitive. *See*
 28 *e.g. Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1147 (9th Cir. 2002) (ENTREPRENEUR

1 for public relations company held likely to be confused with ENTREPRENEUR for magazine);
 2 *Dreamwerks Production Group, Inc. v. SKG Studio*, 142 F.3d 1127, 1131-32 (9th Cir. 1998)
 3 (DREAMWORKS for film studio held likely to be confused with DREAMWERKS for company
 4 that promotes science fiction merchandise and organizes Star Trek conventions); *E. & J. Gallo*
 5 *Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1291 (9th Cir. 1992) (GALLO for cheese held likely
 6 to be confused with GALLO for wine and salame). *Fleischmann Distilling Corp. v. Maier*
 7 *Brewing Co.*, 314 F.2d 149, 151 (9th Cir. 1963) (BLACK AND WHITE for beer held likely to be
 8 confused with BLACK AND WHITE for whisky); *On-line Careline Inc. v. America Online Inc.*,
 9 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000) (ON-LINE TODAY for Internet connection
 10 services held likely to be confused with ONLINE TODAY for Internet content); *In re Martin's*
 11 *Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) (MARTIN'S for
 12 wheat bran and honey bread held likely to be confused with MARTIN'S for cheese); *In re*
 13 *Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM for a buffered solution
 14 equilibrated to yield predetermined dissolved gas values in a blood gas analyzer held likely to be
 15 confused with CONFIRMCELLS for diagnostic blood reagents for laboratory use); *In re Jeep*
 16 *Corp.*, 222 USPQ 333 (TTAB 1984) (LAREDO for land vehicles and structural parts therefor
 17 held likely to be confused with LAREDO for pneumatic tires). Under this law, even if
 18 NutriThrive sold no enteral or parenteral products – which is not true – its activities could still
 19 constitute infringement as long as the public is likely to be confused.

20 Furthermore, even if NutriThrive sold only enteral nutrition products – which is also not
 21 true – the fact that the parties' products are "likely to be encountered by the same persons"
 22 suggests infringement is likely. TMEP § 1201(a)(i). *E. & J. Gallo Winery*, 967 F.2d at 1291
 23 (GALLO salame and cheese are "are sold in the same deli cases in grocery stores"); *Tillamook*
 24 *Country Smoker v. Tillamook County Creamery Ass'n*, 311 F. Supp. 2d 1023, 1042 (D. Or. 2004)
 25 (defendant's TILLAMOOK cheese and plaintiff's TILLAMOOK smoke meats "appear in the
 26 same supermarkets and thus are likely to be encountered by consumers during the same shopping
 27 trip"). BioRx cannot deny that its NutriThrive enteral products and services and Nutrishare's
 28

TPN products and services are likely to be encountered by the same consumer in the marketplace; that is, BioRx and Nutrishare would be in the same proverbial “aisle” of an on-line drug store.

Accordingly, this factor strongly supports a finding of likelihood of confusion.

2. BioRx’s Federal Trademark Application for “NutriThrive” Is Not a Defense to this Action.

a. NutriThrive’s Notice of Allowance is Not a Defense to Trademark Infringement.

Throughout its opposition brief, BioRx cites to the United States Patent and Trademark Office’s granting of a Notice of Allowance for the mark “NutriThrive” as indicative of the fact that there is no likelihood of confusion. Specifically, BioRx states that “the U.S PTO has completed its review of the [NutriThrive] mark by an Examining Attorney, with no citation to the Nutrishare mark as being confusingly similar” (Opp. at 5.) and that Nutrishare “ignores the opinion of the US Patent and Trademark Office, which examined the applications for NutriThrive . . . and found no likelihood of confusion with the Nutrishare marks[.]” (Opp. at 10.)

The reason that Nutrishare has “ignored” the USPTO’s actions with respect to BioRx’s “NutriThrive” application is that the USPTO’s actions do not impact this court’s decision making.⁶ It is well-established that determinations by the USPTO during the trademark application process must be regarded as inconclusive since they are made at its lowest administrative level. *See Chesebrough-Pond’s, Inc. v. Faberge, Inc.*, 666 F.2d 393, 397 (9th Cir. Cal. 1982) (“a decision of the Patent and Trademark Office allowing the registration of Chesebrough’s trademark would not preclude a subsequent infringement action or be determinative of the issues involved”); *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 802 (9th Cir. Cal. 1970); *Self-Insurance Inst. of Am. v. Software & Info. Indus. Ass’n*, 208 F. Supp. 2d 1058, 1071 (C.D. Cal. 2000) (“[a]dministrative decisions of the PTO are not binding on the Court.”) In fact, in practice, the Trademark Trial and Appeal Board (the “TTAB”) routinely

⁶ The only relevance to BioRX’s trademark application is that it constitutes a binding admission by BioRX that a composite mark starting with the “Nutri” prefix used for pharmaceuticals is distinctive and entitled to full protection under the Lanham Act. This is the only conclusion one can draw from BioRX’s attempt to register the NutriThrive mark on the Lanham Act Principal Register.

1 overturns “likelihood of confusion” determinations made by lower-level trademark examiners.
 2 *See e.g., In re The W.W. Henry Co., L.P.*, 82 USPQ2d 1213 (TTAB 2007); *In re Emissive Energy*
 3 *Corp.*, Serial No. 78358172 (June 15, 2006); *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB
 4 2006). Therefore, the Notice of Allowance issued by a single trademark examiner at the USPTO
 5 for the mark “NutriThrive,” and any determinations related to the application, are neither
 6 determinative, conclusive, nor binding upon this Court.

7 Moreover, what BioRx has failed to state is that the USPTO did not even consider the
 8 “Nutrishare” mark in its determination of whether to issue a Notice of Allowance for the
 9 “NutriThrive” mark. The “Nutrishare” mark was never before the examiner who was reviewing
 10 the “NutriThrive” mark because no combination of queries in the examiner’s search for
 11 conflicting marks would have brought to light the “Nutrishare” mark. (Tenud Decl., ¶¶ 3-5, Ex.
 12 A-B.) Therefore, the Examiner’s granting of a Notice of Allowance on the “NutriThrive” marks
 13 says nothing of whether it is likely to be confused with the “Nutrishare” mark.

14 **b. That Nutrishare Has Not Yet Challenged the NutriThrive Mark at the**
 15 **USPTO is Also Not a Defense to Trademark Infringement.**

16 BioRx also argues that the fact that Nutrishare has not yet challenged the “NutriThrive”
 17 marks before the USPTO weighs against granting a preliminary injunction. But the fact that
 18 Nutrishare, although aware of NutriThrive’s pending federal trademark application, chose to
 19 challenge the mark in Court rather than at the USPTO, is inconsequential. Faced with
 20 NutriThrive’s infringement, Nutrishare had several strategic options. Nutrishare could have
 21 challenged NutriThrive’s mark at the USPTO level in lieu of filing this lawsuit, but this would
 22 have accomplished nothing with regard to preventing the likelihood of confusion, as the
 23 cancellation or non-registration of a mark would not have prevented NutriThrive from using the
 24 “NutriThrive” name in commerce. The trademark branch of the USPTO, and the TTAB, have no
 25 power to issue injunctions. They only have the power to register or cancel trademarks on the
 26 Lanham Act registers. Nutrishare could have challenged the mark in tandem with filing this
 27 lawsuit, but this too would have achieved nothing because the USPTO likely would have
 28 suspended Nutrishare’s petition pending resolution of this litigation. *See* TMEP § 510.02.

Nutrishare could also wait to challenge the mark until after the Court rules on its preliminary injunction motion, or after final judgment is entered, since a favorable Court decision likely will be binding on the USPTO and result in a more efficient resolution of Nutrishare's USPTO action. Or, Nutrishare could decide never to challenge NutriThrive's mark, as a finding of infringement and issuance of injunction will be sufficient to preclude NutriThrive from being able to use its trademark in a way that will be likely to confuse the public. The bottom line is that the decision whether to challenge an infringing trademark at the USPTO or through a civil action has no bearing on whether NutriThrive is infringing Nutrishare's marks.

3. **BioRx Cannot Establish an Affirmative Defense of Laches.**

BioRx erroneously argues that Nutrishare's trademark infringement claims are foreclosed under the doctrine of laches because Nutrishare unduly delayed in filing its lawsuit. (Opp. at 16-17.) Citing *Tillamook Country Smoker, Inc. v. Tillamook County Creamery Ass'n*, 465 F.3d 1102, 1108-11 (9th Cir. 2006), and two non-controlling cases decided by district courts in New York and Ohio, BioRx claims that Nutrishare waited "a full year after learning of BioRx's intentions in June, 2007," and that such delay is "inexcusable." (*Id.*) However, BioRx is wrong on the facts and utterly fails to cite the well-established law on laches or analyze the relevant factors, which demonstrate that BioRx has no viable laches defense.

a. **There is a Strong Presumption that Laches is Inapplicable Because Nutrishare Filed its Lawsuit Within Four Years.**

As a preliminary matter, equitable defenses such as laches are not favored by the courts where – as is the case here – injunctive relief has been sought in cases of clear trademark infringement." *United States Jaycees v. San Francisco Junior Chamber of Commerce*, 354 F. Supp. 61, 73 (N.D. Cal. 1972), *aff'd*, 513 F.2d 1226 (9th Cir.1975) (citing *McLean v. Fleming*, 96 U.S. 245, 253 (1877))

Second, the applicable period of delay that is presumed to be "unreasonable" under the laches defense, is four years. *Tillamook Country Smoker, Inc. v. Tillamook Country Creamery Ass'n*, 465 F.3d 1102 (9th Cir 2006) ("To determine the correct limitation period for a laches

claim “where an injunction is sought, courts first determine when the statute of limitations period expired for the most closely analogous action under state law.”) (citing *Jarrow Formulas, Inc. v. Nutrition Now, Inc.*, 304 F.3d 829, 836 (9th Cir. 2002)); *Miller v. Glenn Miller Prods.*, 318 F. Supp. 2d 923 (C.D. Cal. 2004) (the California state causes of action “most closely analogous” to federal trademark infringement are state unfair competition claims under California Business and Professional Code § 17208). If the plaintiff files suit within this four-year period, “the strong presumption is that laches is inapplicable.” *Jarrow Formulas*, 304 F.3d at 836; *Tillamook*, 465 F.3d at 1108.

In this case, Nutrishare waited only six months from when BioRx officially launched the NutriThrive division to file its lawsuit. But even assuming, arguendo, that Nutrishare waited one year, Nutrishare falls well within the four-year period and there is therefore a strong presumption that laches does not apply.

b. Laches is also Inapplicable Under the Six *E-Systems* Factors.

Laches is also inapplicable because Nutrishare’s alleged delay was reasonable in light of the six factors espoused by this Circuit in *E-Systems, Inc. v. Monitek, Inc.*: (1) the strength and value of the trademark rights asserted; (2) plaintiff’s diligence in enforcing the mark; (3) harm to the senior user if relief is denied; (4) good faith ignorance by the junior user; (5) competition between the senior and junior users; and (6) extent of harm suffered by the junior user because of the senior user’s delay. *E-Systems, Inc. v. Monitek, Inc.*, 720 F.2d 604, 607 (9th Cir. 1983); *see also Tillamook*, 465 F.3d at 1108 (after determining expiration of the analogous statute of limitations, district court must consider six E-Systems factors “to determine whether the trademark owner’s delay in filing suit was unreasonable”); *Grupo Gigante*, 391 F.3d at 1102(same); *Internet Specialties West v. ISPwest*, 2006 U.S. Dist. LEXIS 96351, at *15 (C.D. Cal. Nov. 14, 2006) (same). Interestingly, BioRx does not even cite the *E-Systems* factors, let alone analyze them.

Factors (1) and (5) are the same as three of the *Sleekcraft* factors, and are already addressed in Subsections II(A)(1)(a) and (f) above. Factor (3), the harm to Nutrishare, is

1 addressed in great detail in Subsection II(B) below. Analysis of the remaining three factors, (2),
2 (4), and (6), indicates that BioRx does not have a valid laches defense.

3 (i) *Nutrishare was diligent in enforcing its mark.*

4 BioRx also does not have a viable laches defense under the “progressive encroachment”
5 doctrine. The Ninth Circuit has long recognized that “laches cannot bar injunctive relief when an
6 infringing user progressively encroaches on the owner’s mark over time.” *Grupo Gigante S.A. de*
7 *C.V. v. Dallow & Co.*, 391 F.3d 1088, 1103 (9th Cir. 2004). Under this doctrine, laches is not
8 measured from NutriThrive’s first use of the mark, but from the date that NutriThrive’s acts “first
9 significantly impacted on [Nutrishare’s] good will and business reputation. . . . Any change in the
10 format or method of use of the mark or expansion into new product lines or territories should be
11 sufficient to excuse a prior delay.” MCCARTHY, § 31:19. Following this rationale, courts have
12 excused delays of even twenty years on the grounds that the parties did not squarely compete
13 until the respondent either expanded its products/services or expanded into a new territory. *See*
14 *Id.* (citing *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 55 U.S.P.Q.2d 1225 (5th
15 Cir. 2000)).

16 The “progressive encroachment” doctrine is also cited in the *Tillamook* case, on which
17 BioRx relies to make its laches argument. Under *Tillamook*, Nutrishare need not have taken
18 immediate action in the face of *de minimis* infringement by BioRx. Rather, Nutrishare was
19 permitted to wait until BioRx “move[d] into direct competition...selling the same ‘product’
20 through the same channels and causing actual market confusion.” *Tillamook*, 465 F.3d at 1110
21 (quoting *Prudential Ins. Co. of America v. Gibraltar Fin. Corp. of California*, 694 F.2d 1150,
22 1154 (9th Cir. 1982). Specifically, Nutrishare was permitted to wait until BioRx expanded its
23 NutriThrive business “into different regions or into different markets.” *Tillamook*, 465 F.3d at
24 1110 (citing *Grupo Gigante*, 391 F.3d at 1103) (citing also *Prudential Ins.*, 694 F.2d at 1154).
25 Furthermore, under the progressive encroachment doctrine:
26

27 a period of low-profile sales by a fledgling business should not be counted toward
28 laches. The trademark owner is justified in delaying the unleashing of litigation
until it is seen if the infringing business or product line will survive, let alone

1 significantly impact on plaintiff's trademark rights.

2 MCCARTHY, § 31.19.

3 This case is a veritable exemplar of "progressive encroachment." When BioRx made its
4 announcement a year ago, Nutrishare's founders were not aware of the exact nature of
5 NutriThrive's business, the territory in which it intended to provide its products and services, or
6 the extent to which NutriThrive intended to compete with Nutrishare. (Motion at 2:24-28, 3:1-7.)
7 Even when NutriThrive was officially launched in November, 2007, it was unclear that the
8 business would survive. In fact, BioRx admits in its opposition that even today, "NutriThrive is
9 still in its relative infancy," and is in fact only a "nascent competitor" with a mere thirty-six
10 customers nationwide, and which only now has "started to make inroads into [Nutrishare's]
11 market share." (Opp. at 2:12-13, 5:26, 19:26, 1:23-24) Thus, Nutrishare was more than justified
12 in waiting until this fledgling business survived, and after it became clear that BioRx's activities
13 were significantly impacting Nutrishare's trademark rights, to file its lawsuit.

14 (ii) *BioRx did not have good faith ignorance of Nutrishare's trademark.*

15 BioRx may not raise laches as a defense because it infringed Nutrishare's mark
16 notwithstanding its prior knowledge of the registered "Nutrishare" mark. *Competition Specialties*,
17 87 Fed. Appx. at 40 (citing *Danjaq LLC v. Sony Corp.*, 263 F.3d 942, 956-957 (9th Cir. 2001)).
18 That is, BioRx cannot claim laches because it is not a good faith junior user. *Chips 'N Twigs, Inc.*
19 *v. Prives*, 226 F. Supp. 529 (N.D. Cal. 1963); *In re Beatrice Foods Co.*, 429 F.2d 466, 472
20 (CCPA 1970); *Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358 (2d cir. 1959).

21 First, BioRx has admitted that it had actual knowledge of Nutrishare's mark before BioRx
22 used the NutriThrive mark in commerce. BioRx was familiar with the Oley Foundation and its
23 national events; and it knew that Nutrishare was one of exhibitors at the June 2007 conference.
24 (Opp. at 4:5-13.) It was at this event that BioRx first unveiled NutriThrive to the market, so it
25 could not have used its mark in commerce until after that date. (*Id.* at 4:5-7.) It also applied for
26 federal registration of the NutriThrive mark following the conference and after it had knowledge
27 of Nutrishare's mark. (*Id.* at 4:26-28.)
28

1 Second, BioRx also had constructive knowledge of Nutrishare's mark before BioRx used
 2 the NutriThrive mark in commerce. Nutrishare received a federal trademark for its "Nutrishare"
 3 trademark and it has continuously used that mark since 1993. (Motion at 5:19-27, 6:1-6.) BioRx
 4 did not begin to use its mark until 2007. (*Id.* at 8:21-22.)

5 Because BioRx had actual and constructive knowledge of Nutrishare's mark before BioRx
 6 used its mark in commerce, BioRx cannot claim good faith ignorance of Nutrishare's trademark.
 7 Moreover, BioRx intentionally chose "NutriThrive" to trade off of Nutrishare's notoriety and
 8 goodwill. (*Id.* at 1:11-21.) BioRx mimicked Nutrishare's advertising format, mirrored
 9 Nutrishare's web-site functionality, copied Nutrishare's marketing slogans, and solicited and
 10 hired former patients of Nutrishare, as well as their family members, to become spokesperson for
 11 NutriThrive. (*Id.*) In sum, BioRx intentionally infringed on Nutrishare's trademark. Therefore,
 12 BioRx's lack of good faith bars it from raising a laches defense.

13 (iii) *BioRx has suffered minimal prejudice from Nutrishare's Timing of*
 14 *its Lawsuit.*

15 The timing of Nutrishare's infringement claim did not prejudice BioRx. "Prejudice to the
 16 defendant is an essential element of any laches defense." *Grupo Gigante*, 391 F.3d at 1105. Such
 17 prejudice exists when the defendant "has continued to build a valuable business around its
 18 trademark during the time that the plaintiff delayed the exercise of its legal rights." *Id.* However,
 19 this involves more the fact that the defendant continued to operate its business during the laches
 20 period. *Id.* There must be a discernable lost expectation, which occurs when the defendant takes
 21 "actions that it would not have taken or" the defendant suffers "consequences it would not have
 22 suffered had the plaintiff brought suit promptly." *See, e.g., McCarthy* § 31:12).

23 BioRx has not suffered any harm that it would not have suffered had Nutrishare filed its
 24 lawsuit earlier. Before Nutrishare was even aware of NutriThrive, BioRx had already expended
 25 money developing its TPN and enteral products and services, hiring designers to create the names
 26 and logos, employing focus groups, and participating in the 2007 Oley Foundation Conference.
 27 (Opp. at. 3:26-28, 4:1-16.) Although since that time, it has made available a website and
 28 advertised in publications; it would have undertaken the same marketing efforts had it been using

another name. *See Internet Specialties West v. ISPwest*, 2006 U.S. Dist. LEXIS 96351, at *15. Should BioRx be required to use a different mark, the “additional cost for changing stationary, logos, and phone system programming, and registering a new domain name, are minimal.” *Id.* Because BioRx had already sunk most of its costs into its NutriThrive mark before Nutrishare was even aware of “NutriThrive,” and because it would not have spent any less money subsequently marketing a mark other than “NutriThrive,” BioRx has not suffered any appreciable prejudice as a result of Nutrishare’s delay.

c. The doctrine of Inevitable Confusion Also Bars BioRx’s laches defense.

“Because laches is an equitable remedy, laches will not apply if the public has a strong interest in having the suit proceed.” *Jarrow Formulas*, 304 F.3d at 840. “The public’s interest is of overriding importance, and as such, should be considered apart from any presumption of laches.” *Id.* In *Jarrow Formulas*, the Ninth Circuit held that the public interest was especially significant when health and safety concerns are implicated. *Id.*

In Section II(D) below, Nutrishare explains why the public has a strong interest in the issuance of an injunction. For those same reasons, this factor trumps BioRx’s laches defense.

B. NUTRISHARE WILL SUFFER IRREPARABLE HARM UNLESS BIORX IS ENJOINED FROM USING THE “NUTRITHRIVE” MARK.

In its moving brief, Nutrishare established that, although it is presumed to have suffered irreparable harm if it shows a likelihood of confusion, it nonetheless can independently establish that it has suffered irreparable harm as a result of BioRx’s infringement. In response, BioRx claims that (1) Nutrishare cannot establish irreparable harm because it is claiming “erosion of its market share” which is “redressable through an award of lost profits” (Opp. at 18:3-4); and (2) Nutrishare’s alleged delay in filing its lawsuit and move for preliminary injunction forecloses any claims that it has been irreparably harmed (Opp. at 18:5-17.). As set forth below, none of BioRX's arguments has any merit whatsoever.

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1 **1. Erosion of Nutrishare’s Market Share Qualifies as Irreparable Harm**
 2 **Entitling Nutrishare to a Preliminary Injunction**

3 As a preliminary matter, this Court should dispense with BioRx’s argument that
 4 Nutrishare is not entitled to a preliminary injunction based on BioRx’s erosion of Nutrishare’s
 5 market share. There is more than ample authority that permits plaintiffs to obtain injunctive relief
 6 based on a defendant’s threat to their market share. *See, e.g., Doran v. Salem Inn, Inc.*, 422 U.S.
 7 922, 932 (1975) (loss of business); *Grand River Enterprise Six Nations, Ltd. v. Pryor*, 481 F.3d
 8 60, 67 (2d Cir. 2007) (loss of current or future market share); *Stuhlbarg Int’l Sales Co., Inc. v.*
 9 *John D. Brush & Co., Inc.*, 240 F.3d 832, 841 (9th Cir. 2001) (threatened loss of prospective
 10 customers or goodwill).

11 **2. In Addition to the Erosion of its Market Share, Nutrishare Has Lost Control**
 12 **Of its Brand and Reputation to a Newcomer Who May Tarnish It.**

13 This lawsuit is not merely about BioRx “eroding” Nutrishare’s market share. Of
 14 tantamount concern at this stage of this lawsuit is that BioRx’s use of “NutriThrive” has already
 15 caused patients and doctors to become confused and mistakenly believe that Nutrishare and
 16 NutriThrive are either one and the same or are somehow affiliated or related. The consequences
 17 of such confusion could be dire, as Nutrishare no longer has any control over its brand or
 18 reputation.

19 In this case, the evidence of actual confusion as to the affiliation, connection, or
 20 sponsorship between medical goods providers could cause great irreparable harm to Nutrishare.
 21 *AMP, Inc. v. Foy*, 540 F.2d 1181, 1184 (4th Cir. N.C. 1976) (“the trademark registrant could be
 22 harmed by such popular confusion because inferior service by the infringer might be attributed to
 23 the registrant.”); *Ferrari S.p.A. Esercizio Fabbriche Automobili e Corse v. McBurnie*, 1989 U.S.
 24 Dist. LEXIS 13442 (S.D. Cal. 1989) (“Damages caused by trademark infringement are by their
 25 nature irreparable and not susceptible of measurement for a remedy at law”); see also *Ferrari*
 26 *S.p.A. Esercizio Fabbriche Automobili e Corse v. Roberts*, 944 F.2d 1235 (6th Cir. 1991) (“The
 27 Lanham Act, however, was intended to do more than protect consumers at the point of
 28

1 sale...Ferrari's reputation in the field could be damaged by the marketing of [defendant's]
 2 replicas...despite the absence of point of sale confusion.")

3 Imagine if a "NutriThrive" parenteral nutrition solution somehow became adulterated and
 4 caused a child to become ill or die. As BioRx has admitted, "the field of TPN is not a crowded
 5 one." (Opp. at 13:24.) It is a small and relatively insular group of people. If such a tragedy were
 6 to occur, there would no doubt be a flurry of posts on on-line forums such as www.parent-2-
 7 parent.com and other message boards in which parenteral and enteral nutrition patients and their
 8 families – such as the woman Jessica with whom NutriThrive has communicated – actively
 9 participate. The harm to Nutrishare would be incalculable. The goodwill it has established over
 10 the past 17 years would be gone in an instant. This is but one of numerous scenarios that
 11 illustrate the incredible risk Nutrishare now faces in the absence of injunctive relief.

12 3. Nutrishare's Delay Does Not Preclude Irreparable Harm.

13
 14 Nutrishare has already discussed at length why BioRx's laches argument is inapplicable.
 15 Further to these arguments, there is ample authority showing that delay does not automatically
 16 undermine a finding of irreparable harm in a preliminary injunction context. "[D]elay standing
 17 alone does not overturn any presumptions of irreparable injury that otherwise apply." *Praefke*
 18 *Auto Elec. & Battery Co., Inc. v. Tecumseh Products Co.*, 123 F.Supp.2d 470, 479 (E.D.Wis.
 19 2000) (citing *Vaughan Mfg. Co. v. Brikam Intern., Inc.*, 814 F.2d 346, 351 (7th Cir.1987)). Delay
 20 is but one factor in the irreparable harm analysis, and is not conclusive. *Lydo Enterprises, Inc. v.*
 21 *City of Las Vegas*, 745 F.2d 1211, 1213-1214 (9th Cir. 1984).

22 C. **THE BALANCE OF THE HARDSHIPS STRONGLY TIPS IN NUTRISHARE'S** 23 **FAVOR.**

24 In its motion, Nutrishare discussed at length why the harm that would be suffered by
 25 BioRx as a result of a preliminary injunction would be *de minimis*, especially in comparison to
 26 the harm that would be suffered by Nutrishare in the absence of a preliminary injunction.

27 BioRx greatly overstates the harm that it would incur if the requested injunction is granted
 28

1 by claiming that the injunction would “eliminate NutriThrive as a legitimate competitor,”
2 “enjoin” BioRx “from providing enteral care and other infusion products and services,” “shut
3 down NutriThrive,” “terminate the employment” of NutriThrive’s employees, and “cease
4 providing its products and services to the enteral and TPN patients who have come to rely on it.”
5 (Opp. at 17:24-26; 19:14-19.)

6 These statements are specious and ridiculous given the plain words of Nutrishare’s
7 requested injunction, which only seeks that BioRx cease using a name for its products and
8 services that is likely to cause customers to be confused about their source, relationship,
9 affiliation, or sponsorship in relation to Nutrishare. For a multitude of reasons, this request will
10 not unduly harm BioRx.

11 First, BioRx already markets at least three other home infusion products and services
12 under the “BioRx” name. Bringing its enteral and parenteral products within its “BioRx” brand
13 name umbrella would not result in a great burden to BioRx, as it would not result in a complete
14 upheaval of its marketing strategy or require it to modify its letterhead, business cards, or web-
15 site.

16 Second, BioRx only launched the “NutriThrive” product line in November, 2007 and
17 admits that “NutriThrive is still in its relative infancy” (Opp. at 19:26.) and is in fact only a
18 “nascent competitor.” (Opp. at 2:12-13.) Compared to Nutrishare’s seventeen-year investment in
19 the “Nutrishare” name, BioRx has spent only one year developing its “NutriThrive” name. And
20 while BioRx may have announced that it intended to launch NutriThrive nearly a year ago,
21 NutriThrive did not have a single customer at the time, and did not have a web-site until it was
22 officially launched in November, 2007 – only six months ago. (Okamoto PI Declaration, ¶ 15.)
23 Apparently, even today, NutriThrive has a total of only 36 customers (Opp. at 5:26.) This is not
24 the case of Nike having to change its brand name, thereby affecting the millions of Nike
25 customers world-wide. This is a case where BioRx simply can call each of its 36 customers over
26 the course of a single day and let them know that it will be changing the name of NutriThrive.
27 This cannot possibly constitute a great hardship.

28 Third, Nutrishare is not asking BioRx to completely change its “NutriThrive” name or

1 remove the “Thrive” portion from its name, which BioRx asserts to be the most important term in
 2 the “NutriThrive” name that was developed by three graphic designers with the assistance of a
 3 focus group to “convey wellness and positive energy.” (Opp. at 3:26-4:3.) Rather, Nutrishare is
 4 simply asking BioRx to change the “NutriThrive” name to one that is not confusingly similar to
 5 “Nutrishare.”

6 Fourth, even if an injunction is granted, BioRx can continue to provide long-term in-home
 7 TPN and aggressively pursue any TPN consumer it wants to pursue in California, including
 8 Nutrishare’s own customers, as long as it competes fairly in compliance with all applicable laws
 9 and does so under a name other than “NutriThrive.”

10 Fifth, the fact that BioRx may have allegedly spent \$500,000 in developing and promoting
 11 its “NutriThrive” name is of no consequence,⁷ since BioRx was undisputedly aware of the
 12 trademark infringement issue and chose to ignore it. *See Watts Health Systems, Inc. v. United*
 13 *Healthcare Corp.*, 960 F. Supp. 1431, 1437 (C.D. Cal. 1996) (“any monies expended by United
 14 in promoting, advertising or otherwise using the ‘United Healthcare’ mark was accomplished at
 15 its own peril”). Any expenses incurred by BioRx in connection with its new name could have
 16 been avoided had it simply chosen a name not confusingly similar to the federally registered
 17 trademark “Nutrishare” – a trademark BioRx should have known about from day one. Nutrishare
 18 should not be made to suffer great harm as a direct result of BioRx’s incompetence and/or
 19 carelessness in choosing a new name among the infinity of possible names, or its arrogant refusal
 20 to change its name in light of the rights granted to Nutrishare through its registered trademarks.

21 **D. A PRELIMINARY INJUNCTION WILL PROTECT THE PUBLIC INTEREST.**

22 In its moving brief, Nutrishare explained why this case presents a unique instance where
 23 the public interest is implicated by whether or not the Court grants an injunction. Because both
 24 parties are in the medical field, the public could be harmed if medical decisions are made based
 25 on confusion between Nutrishare and NutriThrive. *See, e.g., McLeod v. Hosmer-Dorrance, Inc.*,
 26 1976 U.S. Dist. LEXIS 12289, 192 U.S.P.Q. 683, at *8 (C.D. Cal. 1976) (“The product in

27 ⁷ BioRx twice asserts in its opposition that it has spent \$500,000 on developing the “NutriThrive” name (Opp. at
 28 18:17, 19:24.) In neither instance does BioRx cite to any declarations or other evidence in support of this bald
 assertion.

question here is a medical device used in the care and treatment of serious injury; as such, there is even a greater public interest in insuring that no confusion exists as to the source of plaintiff's and defendant's products") (citations omitted); *see also Morgenstern Chem. Co. v. G.D. Searle & Co.*, 253 F.2d 390, 393 (3rd Cir. 1958) ("in the field of medical products, it is particularly important that great care be taken to prevent any possibility of confusion in the use of trade-marks."); *Alfacell Corp. v. Anticancer Inc.*, 71 U.S.P.Q.2d 1301 (TTAB 2004) ("where the marks are used on pharmaceuticals and confusion as to source can lead to serious consequences, it is extremely important to avoid that which will cause confusion."); *see also In Re Merck. & Co.* 1982 TTAB LEXIS 35 (TTAB 1992); *Ethicon, Inv. v. American Cyanamid Company* 192 U.S.P.Q. 647 (TTAB 1976).

The public interest element goes completely overlooked in BioRx's opposition brief. Consequently, this factor weighs in favor of granting an injunction.

III. CONCLUSION

This is not a "close call." Even though the Court is not required to rigidly apply all eight *Sleekcraft* factors, Nutrishare has demonstrated that all eight factors weigh in its favor, thereby showing that an injunction is required to prevent actual and potential confusion by doctors and patients alike regarding the source, affiliation, relationship, or sponsorship of the products and services offered by the parties. None of BioRx's purported defenses is valid. That it has a pending application for the "NutriThrive" mark with the USPTO that that Nutrishare has not yet challenged this mark are irrelevant. That it purportedly offers primarily enteral products – rather than parenteral products – is entirely misleading and inconsequential. Given the harm that Nutrishare would suffer in the absence of an injunction, and the lack of harm to BioRx should an injunction issue, Nutrishare's request for injunctive relief is entirely appropriate and necessary. For those reasons, Nutrishare respectfully requests that the Court grant this Motion.

1 DATED: August 13, 2008

DOWNEY BRAND LLP

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3 By: /s/ Michael J. Thomas
4 MICHAEL J. THOMAS
5 Attorney for Plaintiff
6 Nutrishare, Inc
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Nutrishare, Inc.

8 UNITED STATES DISTRICT COURT
9 EASTERN DISTRICT OF CALIFORNIA

11 Nutrishare, Inc., a California corporation,
12 Plaintiff,

13 v.

14 BioRx, LLC, an Ohio Limited Liability
15 Company,

16 Defendant.

Case No. 2:08-CV-01252-WBS-EFB

**DECLARATION OF RODNEY
OKAMOTO RE: REPLY IN SUPPORT OF
MOTION FOR PRELIMINARY
INJUNCTION**

Date: August 18, 2008
Time: 2:00 p.m.
Dept: Courtroom 5
Judge: Hon. William B. Shubb

18
19 I, RODNEY OKAMOTO, hereby declare as follows:

20 1. I am an individual residing in Galt, California. I make this declaration of my own
21 personal knowledge, and if called to testify, could and would testify consistent with the facts
22 stated herein.

23 2. I am co-founder and President of Plaintiff in this action, Nutrishare, Inc.
24 (hereinafter "Nutrishare")

25 3. In its opposition papers filed August 4, 2008, BioRx, LLC (hereinafter "BioRx")
26 filed a declaration from Timothy Fensky, who states he is the Director of Pharmacy Operations
27 for Sullivan's Pharmacy and that he "was not confused by BioRx's use of the name NutriThrive."
28

1 BioRx's submission of this declaration is an attempt to call into question the veracity of the
2 declaration I filed with the Court on June 24, 2008. However, in that declaration, I never stated
3 that Mr. Fensky "was confused by BioRx's use of the name NutriThrive." In that declaration, I
4 stated that Mr. Fensky "indicated that the names 'Nutrishare' and 'NutriThrive' could cause
5 confusion among his pharmacists and that he would have to explain the difference to them."

6 4. In supplemental papers filed on August 8, 2008, BioRx, LLC provided the Court
7 with a letter from an attorney, Daniel Cahill, to BioRx's Vice President, Eric Hill, in which Mr.
8 Cahill states that statements I made in my July 8, 2008 supplemental declaration were "inaccurate
9 or taken out of context." Mr. Cahill's letter appears to call my recollection or my integrity into
10 question. In my July 8, 2008 supplemental declaration filed in support of Nutrishare's Motion for
11 Preliminary Injunction, I described a conversation I had with Thomas E. Cesar, president of the
12 Accreditation Commission for Healthcare, Inc. (ACHC), on Wednesday, July 2, 2008. Mr. Cahill
13 did not participate in and has no personal knowledge of this conversation – the conversation was
14 solely between me and Mr. Cesar. It does not appear that either Mr. Cahill or Mr. Cesar have
15 provided the Court with a sworn statement under penalty of perjury, so unfortunately, all I can do
16 is reiterate under penalty of perjury that on July 2, 2008 Mr. Cesar did tell me that both he and the
17 ACHC's Director of Accreditation, Sherry Hedrick, believed that the "NutriThrive" and
18 "Nutrishare" names were very similar, that the public was likely to be confused between the
19 "NutriThrive" and "Nutrishare" name, and that it was not in the best interests of the public to be
20 confused.

21 5. BioRx states that enteral and parenteral therapy are not competitive. But actually,
22 both enteral and parenteral nutrition are medical nutrition therapies that lie along the same clinical
23 care continuum. That is, an individual patient may be able to receive adequate advanced nutrition
24 via an enteral feeding tube, which allows formulas to be delivered directly into the stomach or
25 intestines but that same individual may later require more aggressive nutrition therapy and that
26 may mean parenteral (intravenous) feedings will be the only way that his or her clinical team can
27 make sure that adequate nutrition is provided to the patient.

28 6. The "timeline" of a patient requiring supplemental nutrition therapy may be

1 summarized as follows: A patient with a minimally affected gastrointestinal (“GI”) system can
2 supplement a regular oral diet with an oral nutrition formula such as “Ensure.” A patient with a
3 more severely affected GI system may require enteral nutrition, or delivery of the same oral
4 nutrition formula into the GI tract via an enteral feeding tube, which can enter via the nose or
5 through the skin of the abdomen, directly into the stomach or intestines. A patient with an even
6 more severely affected GI system requires parenteral nutrition, which involves pumping a special
7 intravenous nutrition formula we call “Total parenteral nutrition” through an intravenous catheter.
8 When this is done by the patient in his or her home, we call it ‘Home TPN’. However, some
9 patients are on both enteral and parenteral therapy, some are exclusively on enteral therapy, some
10 are exclusively on parenteral nutrition, some are on enteral therapy and occasionally “revert” to
11 parenteral therapy, and some are on parenteral therapy and may “graduate” to enteral therapy. As
12 I stated in a previous declaration, although Nutrishare focuses on parenteral therapy, it still
13 provides enteral nutrition to its parenteral patients, some of whom are now exclusively on enteral
14 nutrition.

15 7. BioRx has stated that the “customers” for its NutriThrive products are physicians
16 and nurses. Based on my several decades of experience in the home infusion industry in general,
17 and in the home TPN industry specifically, this cannot be true. Enteral and parenteral nutrition
18 consumers and their insurance companies – not doctors – pay home infusion pharmacies for
19 providing pharmaceuticals. The only involvement that physicians and nurses have is to diagnose
20 patients and prescribe parenteral or enteral nutrition therapy. Pharmacies like Nutrishare (and
21 presumably NutriThrive) dispense parenteral nutrition products to patients. Nutrishare is like any
22 other pharmacy in several respects (with the exception that it is a “closed door” pharmacy and not
23 a “brick and mortar” pharmacy). Just as the primary “customer” of Rite-Aid or Walgreens is the
24 patient, the primary “customer” of Nutrishare is the TPN patient, not the doctor. So, just as with
25 any other pharmacy, a doctor might suggest that a patient get his or her prescription filled by
26 “Nutrishare,” or a doctor might directly send a TPN prescription to the pharmacy of the patient’s
27 choice, the doctor might simply give the patient a prescription that the patient can fill at the
28 pharmacy of his or her choice, or, in some cases, the patient’s insurance company might require

1 the patient to use a "contracted pharmacy" in order to receive coverage. So while Nutrishare has
2 professional relationships with doctors and insurance companies, the primary "customer" is the
3 consumer.

4
5 I declare under penalty of perjury under the laws of the United States and the State of
6 California that the foregoing is true and correct to the best of my knowledge.

7 Dated this 12th day of August, 2008, at Galt, California.

8 
9
10 RODNEY OKAMOTO

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UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF CALIFORNIA

Nutrishare, Inc., a California corporation,
Plaintiff,

v.

BioRx, LLC, an Ohio Limited Liability
Company,
Defendant.

Case No. 2:08-CV-01252-WBS-EFB

**DECLARATION OF ELLEN J. TENUD
RE: REPLY IN SUPPORT OF MOTION
FOR PRELIMINARY INJUNCTION**

Date: August 18, 2008
Time: 2:00 p.m.
Dept: Courtroom 5
Judge: Hon. William B. Shubb

I, Ellen J. Tenud, declare as follows:

1. I am a trademark paralegal to counsel at Downey Brand LLP, attorneys of record for Nutrishare, Inc. (hereinafter "Nutrishare") in this action. I have personal knowledge of the facts set forth herein, except to the extent they are stated on information and belief, and, if called to testify, I could and would testify competently to the contents hereof.

2. I have been a trademark paralegal since 1988. In my capacity as a trademark paralegal, I have extensive experience in conducting research for conflicting marks on the United States Patent and Trademark Office ("USPTO") database, as well as other third party commercial databases tailored for trademark research, such as Dialog and the like.

///

1 3. Counsel for Nutrishare requested that I review the Examiner's research conducted
2 during prosecution of the applications for the NutriThrive marks (Serial Nos. 77/229275 and
3 77/229266) to ascertain if, in my experience and opinion, the Examiner would have uncovered
4 Nutrishare's registered trademark "Nutrishare" based on the search query. Attached hereto as
5 Exhibit A are copies of the Examiner's research queries obtained from the United States Patent
6 and Trademark Office's TDR database. The Examiner conducted an identical search in each
7 case. Based on my experience and in my opinion, the Examiner would not have uncovered or
8 been aware of the registered Nutrishare trademark based on the search query.

9 4. Specifically, the Examiner only reviewed marks that contained the letters "n{v}tr"
10 and "thr{v:2}v". This search query would not retrieve marks that are pronounced with the similar
11 sounding prefixes "sh" and/or "ch."

12 5. In order to verify that my analysis and opinion as set forth herein is accurate, I
13 conducted a search on the USPTO TESS "free form" database using the Examiner's research
14 queries verbatim. Attached here to as Exhibit B are copies of the research Session Summary
15 showing the queries that I asked, and copies of the listing of marks uncovered. As can be
16 ascertained from the listing of marks, Nutrishare was never before the Examiner or considered
17 during the Examiner's analysis of the registrability of the NutriThrive marks.

18 6. Counsel for Nutrishare also requested that I conduct research at the USPTO
19 website to ascertain if marks exist that include the prefix "Nutri" either combined with other
20 terms as a solitary word mark, or used as a term separately in a composite mark, that do not
21 include a disclaimer of "Nutri." Attached hereto as Exhibit C is copy of an active Principal
22 Register registration obtained from the USPTO website for the mark "Nutri-Bite" which
23 includes a disclaimer of "Bite," but does not include a disclaimer of "Nutri."

24 7. Counsel for Nutrishare also requested that I review the web-sites
25 www.nutrepletion.com and www.nutricia.com to investigate the nature of the goods and services
26 provided by the web site owners. My review indicated that "Nutrepletion Resources" and
27 "Nutricia" are trade names of businesses, and not product identifiers. Nutricia uses other
28 trademarks for its products such as Nutilis, Nutrilon Royal, Forticare, and Flocare. In addition,

1 neither Nutricia nor Nutrepletion appears to offer total parenteral nutrition services.

2 I declare under the laws of the State of California that the foregoing is true and correct.

3 Executed this 12th day of August, 2008 in Sacramento, California.

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7 ELLEN J. TENUD
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Case No. 2:08-CV-01252-WBS-EFB

DECLARATION OF ELLEN J. TENUD IN RE: REPLY IN
SUPPORT OF MOTION FOR PRELIMINARY INJUNCTION

EXHIBIT A

*** User:mlewis4 ***

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	6	1	5	5	0:01	"biorx"[on]
02	10908	N/A	0	0	0:04	*n{v}tr{v}*[bi,ti]
03	326	N/A	0	0	0:01	*thr{v:2}v*[bi,ti]
04	4	1	3	3	0:01	2 and 3
05	17	8	9	4	0:01	*n{v:2}tr{v:2}th*[bi,ti]
06	54	32	22	13	0:01	*n{v:2}tr\$th*[bi,ti]

Session started 10/18/07 8:55:03 AM

Session finished 10/18/07 10:58:39 AM

Total search duration 0 minutes 9 seconds

Session duration 123 minutes 36 seconds

Default NEAR limit=1ADJ limit=1

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*** User:mlewis4 ***

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
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02	10908	N/A	0	0	0:04	*n{v}tr{v}*[bi,ti]
03	326	N/A	0	0	0:01	*thr{v:2}v*[bi,ti]
04	4	1	3	3	0:01	2 and 3
05	17	8	9	4	0:01	*n{v:2}tr{v:2}th*[bi,ti]
06	54	32	22	13	0:01	*n{v:2}tr\$th*[bi,ti]

Session started 10/18/07 8:55:03 AM

Session finished 10/18/07 10:58:53 AM

Total search duration 0 minutes 9 seconds

Session duration 123 minutes 50 seconds

Default NEAR limit=1ADJ limit=1

Sent to TICRS as Serial Number: 77229275

Case No. 2:08-CV-01252-WBS-EFB

DECLARATION OF ELLEN J. TENUD IN RE: REPLY IN
SUPPORT OF MOTION FOR PRELIMINARY INJUNCTION

EXHIBIT B



UNITED STATES PATENT AND TRADEMARK OFFICE

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No.	Search Terms	Documents	Occurrences
S1	*n{v}tr{v}*[bi,ti]	11627	11994
S2	*thr{v:2}v*[bi,ti]	385	385
S3	S1 and S2	7	14
S4	*n{v:2}tr{v:2}th*[bi,ti]	18	18
S5	*n{v:2}tr\$th*[bi,ti]	57	64

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	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	78360912		NUTRATHRIVE	TARR	DEAD
2	77270816		THRIVE NUTRITION DO MORE THAN SURVIVE	TARR	LIVE
3	77229275		NUTRITHRIVE	TARR	LIVE
4	77423862		THRIVE NUTRITION	TARR	LIVE
5	77376735		NUTRATHRIVE	TARR	LIVE
6	77361485		THRIVE ACTIVE FITNESS CLUBS NUTRITION EXERCISE TRAINERS 24-7	TARR	LIVE
7	77229266		NUTRITHRIVE	TARR	LIVE

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Current Search: S4: *n{v:2}tr{v:2}th*[bi,ti] docs: 18 occ: 18

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	78648881		NUTRATHIN	TARR	DEAD
2	78627949	3160789	NUTRATHIRST	TARR	LIVE
3	78360912		NUTRATHRIVE	TARR	DEAD
4	78273567	2893356	CASINOTRUTH.COM	TARR	LIVE
5	78107737		CASINOTRUTH.COM	TARR	DEAD
6	77264609	3448313	NUTRATHAI	TARR	LIVE
7	77229275		NUTRITHRIVE	TARR	LIVE
8	77376735		NUTRATHRIVE	TARR	LIVE
9	77229266		NUTRITHRIVE	TARR	LIVE
10	76216767	2522371	NUTRITHERAPY	TARR	LIVE
11	75592850	2550386	NUTRITHENE	TARR	LIVE
12	75380577	2292000	NUTRITHYS	TARR	LIVE
13	75333288		NUTRATHERAPY	TARR	DEAD
14	75312576	2211853	NUTRITHERAPY	TARR	LIVE
15	74274510		NUTRATHERAPY	TARR	DEAD
16	74036203	1777236	NEUTRATHERM	TARR	DEAD
17	73769464	1626478	NUTRITHIN	TARR	DEAD
18	72154534	0765715	NEUTROTHERM	TARR	DEAD

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Current Search: S5: *n{v:2}tr\$th*[bi,ti] docs: 57 occ: 64

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	78889775		NUTRA-SMOOTHIE	TARR	DEAD
2	78889760		NUTRI-SMOOTHIE	TARR	DEAD
3	78743280		NUTRAEARTH	TARR	LIVE
4	78662120		NUTRI-EARTH	TARR	LIVE
5	78659004	3262571	NUTRAESTHETICS	TARR	LIVE
6	78648881		NUTRATHIN	TARR	DEAD
7	78627949	3160789	NUTRATHIRST	TARR	LIVE
8	78609666	3116649	NUTRIBATH	TARR	LIVE
9	78570115		NUTRI-HEALTH SOLUTIONS	TARR	DEAD
10	78451622	2992505	NUTRI-THICK	TARR	LIVE
11	78360912		NUTRATHRIVE	TARR	DEAD
12	78345478		NUTRASMOOTH	TARR	DEAD
13	78298853		NUTRASMOOTH	TARR	DEAD
14	78273567	2893356	CASINOTRUTH.COM	TARR	LIVE
15	78195549		NUTRAPATH	TARR	DEAD
16	78107737		CASINOTRUTH.COM	TARR	DEAD
17	77518999		NUTRI-SOOTHE	TARR	LIVE
18	77336055	3467214	NUTRAPATHIC	TARR	LIVE
19	77264609	3448313	NUTRATHAI	TARR	LIVE
20	77229275		NUTRITHRIVE	TARR	LIVE
21	77376735		NUTRATHRIVE	TARR	LIVE
22	77229266		NUTRITHRIVE	TARR	LIVE
23	77220308		NUTRACHEMOTHERAPY	TARR	LIVE

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24	76444262		NUTRIWEALTH	TARR	DEAD
25	76444260	2950850	NUTRIHEALTH	TARR	DEAD
26	76374265		NUTRIHEALTH	TARR	DEAD
27	76235515	2512727	NUTRABREATHE	TARR	LIVE
28	76216767	2522371	NUTRITHERAPY	TARR	LIVE
29	76121576	2831143	NUTRIPATH	TARR	LIVE
30	75715059		NUTRI-HEALTH	TARR	DEAD
31	75592850	2550386	NUTRITHENE	TARR	LIVE
32	75562890		NATRALITH	TARR	DEAD
33	75492729	2277697	NUTRI-CATH	TARR	LIVE
34	75380577	2292000	NUTRITHYS	TARR	LIVE
35	75357545		NUTRA-SMOOTHIE	TARR	DEAD
36	75333288		NUTRATHERAPY	TARR	DEAD
37	75330906		NETRHYTHMS	TARR	DEAD
38	75312576	2211853	NUTRITHERAPY	TARR	LIVE
39	74647667	2030937	NUTRIBATH	TARR	DEAD
40	74274510		NUTRATHERAPY	TARR	DEAD
41	74188423	1777369	NUTRI-HEALTH	TARR	DEAD
42	74069491		NUTRICATH	TARR	DEAD
43	74053545	1635898	MY NUTRI...THE THIRD GENERATION MUSHROOM SUPPLEMENT	TARR	DEAD
44	74036203	1777236	NEUTRATHERM	TARR	DEAD
45	73769464	1626478	NUTRITHIN	TARR	DEAD
46	73745096	1594824	NUTRAPATHIC	TARR	LIVE
47	73715287		NUTRIBATH	TARR	DEAD
48	73561459	1394541	NEUTRAGANTH	TARR	DEAD
49	73533088	1397346	NUTRI-HEALTH	TARR	DEAD
50	73481652		NAADS (NITROMETHANE ANTI-ARMOR DITCHING SYSTEM)	TARR	DEAD
51	73475447		NUTRIPATHY	TARR	DEAD
52	73466198	1329203	NUTRI-THIN	TARR	DEAD
53	73459622	1307890	NUTRI-CATH	TARR	DEAD
54	73054899	1035142	NUTRABATH	TARR	LIVE
55	81017569	1017569	NUTRI-THERMALIZED	TARR	DEAD
56	72260358	0839891	NUTRI-HEALTH	TARR	DEAD
57	72154534	0765715	NEUTROTHERM	TARR	DEAD

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Case No. 2:08-CV-01252-WBS-EFB

DECLARATION OF ELLEN J. TENUD IN RE: REPLY IN
SUPPORT OF MOTION FOR PRELIMINARY INJUNCTION

EXHIBIT C

Int. Cl.: 5

Prior U.S. Cls.: 6, 18, 44, 46, 51 and 52

Reg. No. 3,023,459

United States Patent and Trademark Office

Registered Dec. 6, 2005

**TRADEMARK
PRINCIPAL REGISTER**

NUTRI-BITES

VETS PLUS, INC. (WISCONSIN CORPORATION)
102 3RD AVE. E.
KNAPP, WI 54749

FOR: DIETARY SUPPLEMENTS FOR PETS AND
HORSES, IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND
52).

FIRST USE 5-8-2003; IN COMMERCE 5-8-2003.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE BITES, APART FROM THE MARK
AS SHOWN.

SER. NO. 78-486,389, FILED 9-20-2004.

PATRICIA EVANKO, EXAMINING ATTORNEY

Case No. 2:08-cv-01252-WBS-EFB

REPLY IN SUPPORT OF MOTION FOR
PRELIMINARY INJUNCTION

UNPUBLISHED CASE

1991 U.S. App. LEXIS 10842, *

24 of 154 DOCUMENTS

GUABER, S.P.A., Appellant, v. NUTRI-METICS INTERNATIONAL, INC., Appellee**No. 91-1098****UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT****1991 U.S. App. LEXIS 10842****May 17, 1991, Decided**

NOTICE: [*1] RULE 47.8. OPINIONS AND ORDERS DESIGNATED AS UNPUBLISHED SHALL NOT BE EMPLOYED AS PRECEDENT BY THIS COURT, AND MAY NOT BE CITED BY COUNSEL, EXCEPT IN SUPPORT OF A CLAIM OF RES JUDICATA, COLLATERAL ESTOPPEL, OR LAW OF THE CASE. ANY PERSON MAY REQUEST THAT AN UNPUBLISHED OPINION OR ORDER BE REPREPARED AND REISSUED FOR PUBLICATION, CITING REASONS THEREFOR. SUCH REQUEST WILL BE GRANTED OR DENIED BY THE PANEL THAT RENDERED THE DECISION.

SUBSEQUENT HISTORY: Reported as Table Case at 935 F.2d 281, 1991 U.S. App. LEXIS 17867.

PRIOR HISTORY: Appeal from the United States Patent and Trademark Office Trial and Appeal Board; No. 79,047.

JUDGES: Rich, Archer and Lourie, Circuit Judges.

OPINION BY: ARCHER

OPINION**DECISION**

Guaber, S.P.A. (Guaber) appeals from the decision of the United States Patent and Trademark Office's Trademark Trial and Appeal Board (board) in Opposition No. 79,047 (Sept. 26, 1990), sustaining the opposition of Nutri-Metics International, Inc. (Nutri-Metics) to registration of the mark NEUTROMED and DESIGN by Guaber. We *affirm*.

OPINION

The board determined that a likelihood of confusion exists between Guaber's mark NEUTROMED and DESIGN, and the opposer's mark NUTRI-METICS. This is

a question of law, which we review de novo. *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 853 F.2d 888, 893, 7 USPQ2d 1628, 1632 (Fed. Cir. 1988); [*2] *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1569, 218 USPQ 390, 394 (Fed. Cir. 1985). After considering the evidence before the board on the factors set out in *In re DuPont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973), we conclude that the board correctly determined that the marks when used are likely to cause confusion.

Guaber seeks to register its mark for use on goods substantially identical to those listed in the NUTRI-METICS registration. At oral argument, Guaber's counsel conceded that purchasers of these goods are not sophisticated. Because there is no restriction on the uses or trade channels in NUTRI-METICS' application and because its products are to some extent sold in salons (although most are sold directly to consumers), the board determined that both parties' goods are likely to be distributed through the same or similar trade channels. See *DuPont*, 476 F.2d at 1361, 177 USPQ at 567.

Assessing the "similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression," *DuPont*, 476 F.2d at 1361, 177 USPQ at 567, [*3] we see no error in the board's finding that the marks are confusingly similar in their entireties. While the words NEUTROMED and NUTRI-METICS are not visually identical, the board determined that both use a variation of the same prefix, that the pronunciation of the marks would be virtually identical and confusingly similar to an ordinary purchaser, and that such a purchaser would not attach differing connotations to the marks.

Guaber argues that the marks are strikingly dissimilar if compared *as a whole*, and asserts that the board erred because it dissected Guaber's mark and ignored the significance of the colored design and the term "pH 5.5." We disagree.

1991 U.S. App. LEXIS 10842, *

While marks must be evaluated in their entireties, one feature of a mark may be considered to dominate other features in creating the mark's commercial impression. *Burger Chef Sys., Inc. v. Sandwich Chef, Inc.*, 608 F.2d 875, 877, 203 USPQ 733, 735 (CCPA 1979); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 695 (CCPA 1976). This does not amount to dissection of the mark. It is, rather, a recognition that a typical purchaser would not retain [*4] a mark's details, only a mental impression. See *Giant Food*, 710 F.2d at 1570-71, 218 USPQ at 395. In finding that the word NEUTROMED dominated Guaber's mark, the board did not disregard the non-word portions of the mark; the board merely concluded that a consumer viewing the mark would attach greater significance to the word NEUTROMED than to the colored design or to the "pH 5.5" reference. In so doing, the board did not err.

Notwithstanding the colors and reference to "pH 5.5," the dominant feature of the mark is clearly the word NEUTROMED. Further, the term "pH 5.5" was disclaimed in Guaber's application and was shown to be descriptive. See *In re National Data Corp.*, 753 F.2d 1056, 1059, 224 USPQ 749, 751 (Fed. Cir. 1985) ("That a particular feature is descriptive . . . with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark.").

Guaber also contends that the third party registrations it submitted show that opposer's NUTRI- prefix is weak and should be afforded little protection. We agree with the board that "even if we were to consider the [NUTRI- [*5] prefix] to be weak, that would not preclude a likelihood of confusion if, in their entireties, the marks are so alike as to be confusingly similar." The board correctly found that to be the case here.

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